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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,589	07/02/2003	Sakae Suda	1232-5077	5542
27123	7590	11/24/2006		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/613,589

Applicant(s)

SUDA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3,5 and 7-11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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Attachment to Advisory Action

1. Applicants' amendment filed 11/10/06 has been fully considered but the amendment has not been entered given that it raises new issues that would require further consideration and search.

Specifically, the amendment raises new issues that would require further search given that while previously the present claims required composition comprising "solvent or dispersion medium", present claim 1 has been amended to recite that the composition requires "aqueous medium". This would require new searches given that while previously the claims were open to composition comprising any solvent or dispersion medium including organic solvent, the claims are now limited to those comprising aqueous medium.

Further, the amendment raises new issues that would require further consideration under 37 CFR 1.75(c) given that each of claim 3 and claim 5 are in improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, claim 3, which depends on claim 1, recites that the polymer compound is amphipathic and claim 5, which depends on claim 1, recites that the monomer unit of general formula (1) is incorporated in a hydrophobic block segment of the polymer compound while claim 1 recites that the polymer compound is an amphipathic block polymer compound including a hydrophobic block segment having a monomer unit represented by formula (1). Thus, claim 3 and claim 5 each fail to further limit the scope of the claim on which they each depend, namely, claim 1 given that claim 3 and claim 5 recite the same limitations already disclosed in claim 1.

Further, the amendment raises new issues that would require further consideration under 35 USC 112, second paragraph given that claim 1 in lines 5-6 recites that "the polymer

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compound is an amphipathic block polymer compound including a hydrophobic block segment having a monomer unit represented by formula (1)” and also recites in line 17 “wherein the polymer compound is a block polymer”. Thus, the scope of the claim is confusing given that there are two different recitations in claim 1 regarding the polymer compound and thus, it is not clear what the polymer compound encompasses.

It is noted that *if* the amendment filed 11/10/06 were entered, the amendment would overcome the rejection of record utilizing Sato et al. ‘904 (U.S. 2003/0232904). However, the amendment would not overcome the rejection of record utilizing Sato et al. ‘343 (U.S. 2003/0236343).

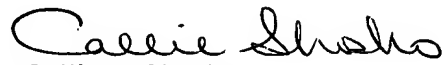
Specifically, applicants argue that Sano et al. ‘343 is not a relevant reference against the present claims given that while Sano et al. ‘343 disclose block polymer comprising hydrophobic block and hydrophilic block that is obtained from monomer of presently claimed formula (1), there is no explicit disclosure in Sano et al. ‘343 that the monomer is in the hydrophobic block segment of the polymer as required in the present claims.

On the one hand, however, given that Sano et al. disclose monomer identical to that presently claimed and block polymer comprising hydrophobic block and hydrophilic block as presently claimed, it is clear that the monomer would inherently also be part of the hydrophobic segment of the polymer as presently claimed.

On the other hand, given that Sano et al. disclose monomer identical to that presently claimed, which includes those that are hydrophobic, it is clear that such monomer would inherently be incorporated into the hydrophobic block segment of the polymer.

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Thus, it is the examiner's position that even if the amendment were entered, Sano et al.
'343 would remain a relevant reference against the present claims.



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CS
11/20/06